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EXAMINER

GORT, ELAINE L

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 27

Application Number: 09/298,889
Filing Date: April 26, 1999
Appellant(s): GANESAN, RAVI

Sterling W. Chandler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/9/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 7, 8, 12-14, 17, 22, 23, 26, 27 and 29-32 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7, 8, 12-14, 17, 22, 23, 26, 27 and 29-32 are rejected under 35 U.S.C.

102(e). This rejection is set forth in prior Office Action, Paper No. 23.

Claims 7, 8, 12-14, 17, 22, 23, 26, 27 and 29-32 are rejected under 35 U.S.C.

103(a). This rejection is set forth in prior Office Action, Paper No. 23.

Claims 7, 8, 12-14, 17, 22, 23, 26 and 27 rejected under 35 U.S.C. 112. This rejection is set forth in prior Office Action, Paper No. 23.

(11) Response to Argument

• **Due Process in the Examination**

Appellant has argued that they have not received a full, fair and impartial hearing as evidenced by the Examiner persistently failing "to properly consider detailed arguments presented in traversal of the prior art rejections, and has failed to provide any reasonable or understandable basis for rejection or maintaining the rejection in view of the points explicitly raised in response to Official Actions" and that it is because of this that a "clear issue" has never been reached with respect to the claims.

It is unclear from the Appellant's Due Process argument what arguments specifically have not been addressed. Examiner contends that the Appellant was given a full, fair and impartial hearing when the Examiner addressed the Appellant's arguments by responding with further detailed rejections and explanations of the rejections. The Examiner and her SPE have also provided two thorough interviews,

one in July 2002 and another in September 2003 where in person explanations of the rejections were provided.

- **Prima Facie Case Argument Responses**

Appellant's Argument #1: Chang's Electronic check is not a directive to transfer funds to a deposit account (claims 7, 14 and 29)

Appellants have argued that Chang's electronic check is not a directive to transfer funds to a deposit account.

The claims merely recite "to transmit a directive", or "to generate directives", to transfer funds to different deposit accounts which Examiner contends is done when the electronic check of Chang is created, retrieved by and transmitted to the payee to be endorsed and electronically deposited into the Payee's Bank (see figure 5 and column 4 lines 52+). Examiner has taken the definition of a directive to be "something that serves to direct, guide, and impel toward an action or goal" as found in Merriam-Webster's collegiate dictionary, 10th Edition, 1996 for which an electronic check forwarded to a payee serves to direct, guide and impel the associated funds toward an action or goal (payee's bank account). All the actions taken in generating the electronic check with envelope and processing carried out until the funds are finally transferred into the payee's account serve "to direct, guide and impel" a transfer of funds to the payee's account and thus constitute the generation and transmission of a "directive" to transfer funds to a deposit account.

Appellant's Argument #2: Chang lacks any storage of remittance information
(claims 7 and 29)

Appellants have argued that Chang discloses remittance information included in the electronic check transmitted to the payee and thus lacks any need for, and any disclosure of, storage of generated remittance information.

The claims recite "a central database configured to store the generated remittance information" to be accessible to a payee which Examiner contends is done when the generated remittance information included in the electronic check of Chang (see column 7 lines 10-15 and lines 35-60) is stored within the electronic envelope which is forwarded and stored at the payee's designated computing system routing destination (see column 10 lines 1-6) which the Examiner identifies as a "central database". Remittance information is generated and contained within the electronic check (for example remittance information includes the payment amount and payor's identification) which is later stored in an electronic envelope at the payee's designated routing destination for the payee to later access and process both the check and the remittance information.

Appellant's Argument #3: Chang lacks anything to suggest that a payee
transmits a request to access stored remittance information stored by the
payee's bank (claims 7, 14 and 29)

Appellants have argued that Chang lacks anything to suggest that a payee transmits a request to access stored remittance information stored by the payee's bank.

Appellant argues that the payee's receipt of an electronic check can in no way be construed to be a request for, retrieval of, and transmission of, stored remittance information. Appellant further argues that Chang explicitly discloses that remittance information is pushed to the payee and therefore that there is no need for the payee to request to pull remittance information.

The claims recite "a processor configured to receive a request to access the remittance information", "to retrieve the remittance information from the central database based on the received access request", and "to transmit the retrieved remittance information" to the user station. Examiner contends this is done inherently when the payee requests to view the electronic checks stored at the payee's designated computing system routing destination, or "central database", in order for the payee to processes them for depositing (see column 10 lines 1-6). In order for the payee to view the electronic checks on their computer screen a request must be sent to their storage location in order for the system to send the stored electronic checks from the location they are saved at (checks are stored at the designated computing system routing destination which Examiner contends is a "central database", (see column 10 lines 1-6)). The system then retrieves the remittance information, in the form of the electronic check, from this "central database" based on the payee's request, and the system then transmits the retrieved remittance information (electronic check) to the payee's computer screen at which point the payee can use the remittance information to update accounting records and to send the check on for depositing. The electronic check information is inherently requested and sent to the payee's workstation computer screen

(see column 5, lines 21-34) in order for the payee to view and process the electronic checks (see column 7, lines 34-44) which have been previously stored at the designated computing system routing destination (see column 10, lines 1-6).

In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., that the remittance information is stored by the payee's bank) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner would like to note that Chang in fact does disclose remittance information stored by the payee's bank (column 5 lines 43+ discloses a bank's primary memory which contains electronic envelopes transmitted to payees, column 10 lines 36+ discusses a bank representing both payor and payee) even though the claims do not recite this feature.

Appellant's Argument #4: Chang does not disclose transmission of a directive to a payer bank or other financial institute (claims 8, 22, 23 and 31)

Appellants have argued that Chang does not disclose transmission of a directive to a payer bank or other financial institute.

The claims recite "to transmit a directive", or "to generate directives", to transfer funds to different deposit accounts at financial institutes which Examiner contends is done when the electronic check of Chang is created, retrieved by and transmitted to the

Payee, endorsed by the payee, and electronically deposited into the Payee's Bank (see figure 5 and column 4 lines 52+). The payee's bank is a financial institute. Examiner has taken the definition of a directive to be "something that serves to direct, guide, and impel toward an action or goal" as found in Merriam-Webster's collegiate dictionary, 10th Edition, 1996. All the actions taken in generating the electronic check with envelope and processing carried out until the funds are finally transferred into the payee's account serve "to direct, guide and impel" a transfer of funds to the payee's account and thus constitute the generation and transmission of a "directive" to transfer funds to a deposit account.

Appellant's Argument #5: Chang does not disclose a central database for storing remittance information generated responsive to a received payment request (claim 12)

Appellants have argued that Chang does not disclose a central database for storing remittance information generated responsive to a received payment request.

Examiner contends that Chang discloses a central database for storing remittance information generated responsive to a received payment request when the generated remittance information included in the electronic check of Chang (see column 7 lines 10-15 and lines 35-60) is stored within the electronic envelope when the payor pays the bill which is then forwarded and stored at the payee's designated computing system routing destination (see column 10 lines 1-6) which the Examiner identifies as a "central database". Remittance information is generated and contained within the

electronic check (for example remittance information includes the payment amount and payor's identification) which is later stored in an electronic envelope at the payee's designated computer of which it was routed to.

Appellant's Argument #6: Chang does not disclose a processor capable of accessing remittance information for the first payee, access billing information for the second payer, and to transmit accessed remittance information to the first payee and the accessed billing information to the second payer (claim 13)

Appellants have argued that Chang does not disclose a "processor which accesses the remittance information at the request of the first payee also be able to access the billing information at the request of the second payer, and additionally to transmit the accessed remittance information to the first payee and the accessed billing information to the second payer".

Examiner contends that Chang discloses a processor which accesses the remittance information at the request of the first payee also be able to access the billing information at the request of the second payer, and additionally to transmit the accessed remittance information to the first payee and the accessed billing information to the second payer. Chang discloses a system which processes access to remittance information for multiple payees and also processes access to billing information for multiple payers and therefore discloses a processor capable of performing these functions. See figure 2 showing multiple payor and payees obtaining processed requests from the Chang system.

Appellant's Argument #7: Chang does not disclose remittance information having different information segments (claims 17 and 30)

Appellants have argued that Chang does not disclose remittance information having different information segments.

Examiner contends that Chang does disclose remittance information having different information segments in column 7, line 14 when it discusses the instances for single electronic bills designating two or more payees with separate payment to each payee (integrated bills) where two or more companies are providing services but bill together, each electronic check sent to the payee's would included remittance information with different information segments.

Appellant's Argument #8: Chang does not disclose the processor being configured to transmit the directive after the receipt of the request to access the remittance information (claims 26, 27, and 32)

Appellants have argued that Chang does not disclose the processor being configured to transmit the directive after the receipt of the request to access the remittance information.

Examiner contends that Chang does disclose the processor being configured to transmit the directive after the receipt of the request to access the remittance information. As the payee must view the electronic check and endorse it in order to make the deposit, the processor is configured to transmit the directive to the payee only

after the payee has requested to access the electronic check which includes the remittance information (column 4 line 56).

Appellant's Argument #9: The claims are not indefinite under 35 USC 112 (claims 7, 8, 12-14, 17, 22, 23, 26 and 27)

Appellants have argued that the instruction to pay a bill and the directive is not redundant as the instruction to pay a bill of a payee is received at a central station after which receipt of the instruction the central station generates a directive to transfer funds to a deposit account associated with the payee.

Examiner agrees with the Appellant's argument and withdraws the rejection under 35 USC 112.

For the above reasons, it is believed that the rejections should be sustained.

(12) Conclusion

On February 3, 2004 an Appeal Conference between Examiner, James Trammell and Richard Chilcot was held to discuss the appropriateness of the Examiner's rejections. It was decided to maintain the Examiner's art rejections and withdraw the 112(2nd) rejection.

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Art Unit: 3627

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Respectfully submitted,

EG


February 9, 2004

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